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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGO, LIEN M

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,349

Applicant(s)

GODSHAW ET AL.

Examiner

LIEN TM NGO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/2/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 4 and 7 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-7 of U.S. Patent No. 6,460,668.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims 2-7 anticipate substantially all limitation of the application claims 1, 3, 4 and 7.

Terminal Disclaimer

The application/patent being disclaimed should be 6,460,668.

DETAILED ACTION

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 4, the board member includes precut slots and first and second passages, which is not supported in the specification.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Shea et al. (5,782,325) in view of Stube (5,498,101) and further in view of Van Himbeeck (5,566,797).

O'Shea et al. disclose, in figs. 1, 2 and 10, a luggage comprising a flexible fabric comprising both a lateral side 12 and a bottom side 15, and L shaped rigid board member (40 or 90) cover by said fabric, a telescoping handle fastened to the inside of the board member, the board member including a precut slots to receive wheel housing, a L-forming bracket on the outside the board member.

O'Shea et al. does not disclose a support foot fastened to the bottom side of a board member.

Stube teaches a support foot 56 fastened to a bottom side of a board member 28 of carrying case.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the luggage of O'Shea with a support foot fastened to the bottom side of the board member, as taught by Stube, in order to support the luggage when it in an up right position.

O'Shea et al. in view of Stube does not disclose the fabric in the form of a pocket and the L shaped board member inserted into the pocket fabric.

Van Himbeeck teaches, in figs. 3 and 15, a luggage comprising an L shaped board member 56, a flexible fabric sleeve 132 in the form of a pocket, and the L shaped board member inserted into the pocket fabric.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the luggage of O'Shea et al. in view of Stube with the cover fabric in form of pocket and the L shaped board member inserted

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into the pocket fabric, as taught by Van Himbeeck, in order to provide an aesthetic liner to cover the board member.

Examiner notes that, the limitation of "fitted and inserted" in claim 1 is considered as a process of making a apparatus in a product-by process claim; therefore, it is not given a patentable weight, see MPEP 2113.

3. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Himbeeck (5,566,797) in view of O'Shea et al. (5,782,325) and further in view of Stube (5,498,101).

Van Himbeeck discloses, in figs. 1, 3 and 15, a luggage comprising a flexible fabric 132 comprising both a lateral side 34 and a bottom side 38, and L shaped rigid board member 56 cover by said fabric (see col. 8, lines 30-38), a telescoping handle fastened to the inside of the board member, the board member including a precut slots 138 to receive wheel housing.

Van Himbeeck does not disclose a forming bracket on the outside the board member.

O'Shea et al. teach a carrying case having L shaped rigid board member and a L-forming bracket on the outside of the board member.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a L-forming bracket on the outside of the board member in the Van Himbeeck carrying case, as taught by O'Shea et al., in order to secure the board member to the cover material of the luggage.

Van Himbeeck in view of O'Shea et al. does not disclose a support foot fastened to the bottom side.

Stube teaches a support foot fastened to a bottom side of carrying case.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the luggage of Van Himbeeck with a support foot fastened to the bottom side, as taught by Stube, in order to support the luggage when it in an up right position.

Examiner notes that, the limitation of "fitted and inserted" in claim 1 is considered as a process of making a apparatus in a product-by process claim; therefore, it is not given a patentable weight, see MPEP 2113.

4. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lathouwer (6,702,164) in view of O'Shea et al. and Stube, an further in view of Van Himbeeck.

Lathouwer discloses, in figs. 1-4, a luggage comprising a L-shaped rigid board member 2, a telescoping handle fastened to the inside of the board member, the board member including a precut slots 8 to receive wheel housing, and the case comprising plurality of compartments, and a flexible fabric covering the board member,

O'Shea et al. teach a bracket as claimed, and Stube teaches a foot support.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify De Lathouwer luggage with a support foot, and a bracket in order to support the case in an up right position and secure the board member to cover material of the carrying case.

Van Himbeeck teaches, in figs. 3 and 15, a luggage comprising an L shaped board member 56, a flexible fabric sleeve 132 in the form of a pocket, and the L shaped board member inserted into the pocket fabric.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the luggage of De Lathouwer in view of O'Shea et al. and Stube with the cover fabric in form of pocket and the L shaped board member inserted into the pocket fabric, as taught by Van Himbeeck, in order to provide an aesthetic liner to cover the board member.

Examiner notes that, the limitation of "fitted and inserted" in claim 1 is considered as a process of making a apparatus in a product-by process claim; therefore, it is not given a patentable weight, see MPEP 2113.

Allowable Subject Matter

5. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 5/5/06 have been fully considered but they are not persuasive. Applicant argues that the combination of the prior art does not teach the board being fitted and inserted into a fabric pocket. However, the limitation of "fitted and inserted" in claim 1 is considered as a process of making a apparatus in a product-by process claim; therefore, it is not given a patentable weight, see MPEP 2113.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIEN TM NGO whose telephone number is 571-272-4545. The examiner can normally be reached on Monday through Friday from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL MAR can be reached on 571-272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LIEN TM NGO
Primary Examiner
Art Unit 3754

January 2, 2006

